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EXAMINER

HAQ, NAEEM U

ART UNIT PAPER NUMBER

3625

DATE MAILED: 09/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/498,698

Applicant(s)

LEE, REID

Examiner

Naeem Haq

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 89-134 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 89-97, 106, 109-119, 121 and 131-134 is/are rejected.
- 7) ☒ Claim(s) 98-105, 107, 108, 120 and 122-130 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Appeal Brief

In view of the Appeal Brief filed on June 10, 2004, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Claim Objections

Claim 116 is objected to because of the following informalities: This claim recites "...the configured measurement system" in lines 2 and 3. There is insufficient antecedent basis for this limitation in the claim. Appropriate correction is required.

Allowable Subject Matter

Claims 98-105, 107, 108, 120, 122-130 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: Claims 98 and 120 are directed to selecting an image of a customizable component within the image of a configured product to configure that particular customizable component. Motomiya, the cited prior art, teaches that a component is selected outside the image of the configured product (see Figure 5B, item "55" and Figure 6A, item "61").

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 89-97, 106, 109, 110, and 133 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henson (US 6,167,383) in view of Mitchell et al (US Patent 5,710,727) and further in view Motomiya et al (US 6,083,267).

Referring to claims 89-92, and 133, Henson teaches a method and program for enabling a user to configure a computer system in an e-commerce system, wherein the e-commerce system includes a client system coupled through a network to an electronic commerce server, the method and program comprising:

- receiving a request from a user of the client system to configure the computer system, wherein the product includes one or more customizable components (column 4, lines 36-52), wherein at least one of the customizable components is a measurement device (Figure 3A and 4). The Examiner notes that Henson allows a user to configure a speaker which is inherently a measurement device (transducer) since it converts electrical energy into acoustic energy;
- providing customizable component options of the customizable components to the client system for display after receiving said request (Figures 3A, 3B, 4, and 5; column 6, lines 18-43). The Examiner notes that once a user clicks on the selection arrow (Figure 4, item "82") a menu opens up which provides a display of the customizable component options of the customizable components;
- receiving customizable component selections for at least one of the one or more customizable components of the computer system in response to user input, wherein the customizable component selections applied to the computer system specify a configured computer system (Figures 3A, 3B, 4, and 5; column 6, lines 18-43; Figure 6, item "104").

Henson does not teach that the computer system is a measurement system. However, Henson teaches that his invention allows a user to configure a "product" online (column 4, lines 40-47). Furthermore, Mitchell teaches that a computer system is an art recognized equivalent for a measurement system, and that virtual instruments (i.e. computers) have replaced stand-alone hardware instruments (e.g. oscilloscopes, pressure sensors, etc.) (column 1, line 30 – column 2, line 11). Mitchell goes on to

teach that an instrumentation system is nothing more than a computer system that has been customized with software and hardware by stating "Virtual instrumentation comprises general purpose computers and workstations combined with instrumentation software and hardware to build a complete instrumentation system." (column 1, line 66 – column 2, line 2). However, the Examiner notes that Henson's invention is directed to customizing software and hardware on a computer system (Figures 3A and 4). Henson teaches that a user can configure a variety of hardware and software on a computer system. Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to use Henson's product configuration method and program to configure a measurement system since the difference between a measurement system and a computer system is in the hardware and software which Henson allows a user to customize. One of ordinary skill in the art would have been motivated to do so in order to obtain performance efficiencies as taught by Mitchell. Henson also does not teach providing an image of the configured system to the client system for display, wherein the image of the configured system visually depicts the customizable component selections of the user. However, Henson provides a text display of the configured system (Figure 6, item "104") and shows an image of a "Dell Dimension XPS R" computer system (Figures 3A and Figure 4, item "70"). Furthermore, Motomiya teaches an Internet-based configuration method and program that allows a user to configure a variety of products (Abstract). Motomiya teaches displaying an image of the customized product to the client system wherein the image of the customized product visually depicts the customizable component selections of the

user at their respective locations on the image of the customized product (column 5, lines 41-67; column 6, lines 1-35; Figure 6A, item 63). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Motomiya into the method and program of Henson and Mitchell. One of ordinary skill in the art would have been motivated to do so in order to provide the customer of Henson's product configuration method and program with a visual display of the custom configured product, as taught by Motomiya. Motomiya also teaches providing customizable component selection images corresponding to the customizable component selections of the user (Figure 6A, item "62"), visually depicting a subset of the customizable component selection images at their respective locations on the image of the configured product (Figures 5A-6B), and displaying a subset of the customizable component selection images in the image of the configured product (Figures 5A-6B). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Motomiya into the method and program of Henson and Mitchell. One of ordinary skill in the art would have been motivated to do so in order to provide the customer with a more realistic image of the configured product. The Examiner notes that Henson and Motomiya are directed to the same problem area and same field of endeavor (i.e. online configuration of a product) and are therefore analogous art.

Referring to claim 93, the cited prior art does not teach providing text corresponding to the customizable component selections of the user, or that the text is visually depicted proximate to respective locations of the customizable components

comprised in the image of the configured product. However, the Examiner notes that these limitations are not functionally involved in the steps of the recited method and program. Therefore these limitations are deemed to be nonfunctional descriptive material. The steps of receiving and providing would be performed the same regardless of what or where text was displayed on the image of customizable components. The differences between the Applicant's text and the prior art are merely subjective. Thus this nonfunctional descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994) also see MPEP 2106. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to place any information anywhere in the configured product of the cited prior art because such information does not functionally relate to the steps of the claimed method and program and because the subjective interpretation of information does not patentably distinguish the claimed invention.

Referring to claim 94, Motomiya teaches that the image of the configured product appears substantially like the product (Figures 5A-6B). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Motomiya into the method and program of Henson and Mitchell. One of ordinary skill in the art would have been motivated to do so in order to provide the user with a realistic image of the configured product.

Referring to claim 95, Motomiya teaches that the image of the configured product is viewable by the user and used by the user to evaluate and confirm the customizable component selections (Figures 5A-6B). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate this feature into the method and program of cited prior art. One of ordinary skill in the art would have been motivated to do so in order to allow a user to see and interact with the configured product.

Referring to claim 96, Motomiya teaches receiving one or more new customizable component selections for at least one of the one or more customizable components of the configured product after said providing the image of the configured product to the client system, wherein the new customizable component selections applied to the configured product specify a new product, and providing an image of the new configured product, wherein the image of the new configured product visually depicts the new customizable component selections of the user (Figures 5A-6B). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate these features into the prior art. One of ordinary skill in the art would have been motivated to do so in order to allow a user to see the product as it was being configured.

Referring to claim 97, Henson teaches receiving user input selecting a first customizable component; providing a menu of possible options for the first customizable component to the client system for display after the user input selecting the first customizable component; receiving user input selecting one of the possible options for

the first customizable component (Figures 3A and 4). Henson teaches that the user is provided with scroll-down menus for the customizable components. These menus provide the user with options for each customizable component.

Referring to claim 106, Motomiya teaches providing images of the customizable component options to the client system (Figures 5A-6B). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Motomiya into the method and program of the cited prior art. One of ordinary skill in the art would have been motivated to do so in order to allow the user view each component during the customization process, as taught by Motomiya.

Referring to claim 109, Henson teaches the client system displaying one or more customizable component options of the customizable components in response to said providing the one or more customizable component options of the customizable components to the client system (Figures 3A, 3B, 4, and 5; column 6, lines 18-43). The Examiner notes that once a user clicks on the selection arrow (Figure 4, item "82") a menu opens up which provides a display of the customizable component options of the customizable components. Henson does not teach displaying the image of the configured system wherein the image visually depicts the customizable component selections of the user. However, Henson provides a text display of the configured system (Figure 6, item "104") and shows an image of a "Dell Dimension XPS R" computer system (Figures 3A and Figure 4, item "70"). Furthermore, Motomiya teaches an Internet-based configuration method and program that allows a user to configure a

variety of products (Abstract). Motomiya teaches displaying the image of the configured product in response to said providing the image of the configured product to the client system for display, wherein the displayed image of the configured product visually depicts the customizable component selections of the user (Figures 5A-6B). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Motomiya into the method and program of Henson and Mitchell. One of ordinary skill in the art would have been motivated to do so in order to provide the customer of Henson's product configuration method and program with a visual display of the custom configured product, as taught by Motomiya.

Referring to claim 110, Henson teaches that the customizable component selections include a measurement card (video card and sound card) and a transducer (speakers) (Figures 3A and 4).

Claims 111-119, 121, 131, 132, and 134 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henson (US 6,167,383) in view of Motomiya et al (US 6,083,267).

Referring to claims 111-114, and 134, Henson teaches a method and program for enabling a user to configure a computer system in an e-commerce system, wherein the e-commerce system includes a client system coupled through a network to an electronic commerce server, the method and program comprising:

- receiving a request from a user of the client system to configure or purchase the computer system, wherein the computer system includes one or more customizable components (column 4, lines 36-52);

- providing customizable component options of the customizable components to the client system for display after receiving said request (Figures 3A, 3B, 4, and 5; column 6, lines 18-43). The Examiner notes that once a user clicks on the selection arrow (Figure 4, item "82") a menu opens up which provides a display of the customizable component options of the customizable components;
- receiving customizable component selections for at least one of the one or more customizable components of the computer system in response to user input, wherein the customizable component selections applied to the computer system specify a configured computer system (Figures 3A, 3B, 4, and 5; column 6, lines 18-43; Figure 6, item "104").

Henson also does not teach providing an image of the configured system to the client system for display, wherein the image of the configured system visually depicts the customizable component selections of the user. However, Henson provides a text display of the configured system (Figure 6, item "104") and shows an image of a "Dell Dimension XPS R" computer system (Figures 3A and Figure 4, item "70").

Furthermore, Motomiya teaches an Internet-based configuration method and program that allows a user to configure a variety of products (Abstract). Motomiya teaches displaying an image of the customized product to the client system wherein the image of the customized product visually depicts the customizable component selections of the user at their respective locations on the image of the customized product (column 5, lines 41-67; column 6, lines 1-35; Figure 6A, item 63). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to

incorporate the teachings of Motomiya into the method and program of Henson. One of ordinary skill in the art would have been motivated to do so in order to provide the customer of Henson's product configuration method and program with a visual display of the custom configured product, as taught by Motomiya. Motomiya also teaches providing customizable component selection images corresponding to the customizable component selections of the user (Figure 6A, item "62"), visually depicting a subset of the customizable component selection images at their respective locations on the image of the configured product (Figures 5A-6B), and displaying a subset of the customizable component selection images in the image of the configured product (Figures 5A-6B). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Motomiya into the method and program of Henson. One of ordinary skill in the art would have been motivated to do so in order to provide the customer with a more realistic image of the configured product. The Examiner notes that Henson and Motomiya are directed to the same problem area and same field of endeavor (i.e. online configuration of a product) and are therefore analogous art.

Referring to claim 115, the cited prior art does not teach providing text corresponding to the customizable component selections of the user, or that the text is visually depicted proximate to respective locations of the customizable components comprised in the image of the configured product. However, the Examiner notes that these limitations are not functionally involved in the steps of the recited method and program. Therefore these limitations are deemed to be nonfunctional descriptive

material. The steps of receiving and providing would be performed the same regardless of what or where text was displayed on the image of customizable components. The differences between the Applicant's text and the prior art are merely subjective. Thus this nonfunctional descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994) also see MPEP 2106. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to place any information anywhere in the configured product of the cited prior art because such information does not functionally relate to the steps of the claimed method and program and because the subjective interpretation of information does not patentably distinguish the claimed invention.

Referring to claim 116, Motomiya teaches that the image of the configured product appears substantially like the product (Figures 5A-6B). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Motomiya into the method and program of Henson. One of ordinary skill in the art would have been motivated to do so in order to provide the user with a realistic image of the configured product.

Referring to claim 117, Motomiya teaches that the image of the configured product is viewable by the user and used by the user to evaluate and confirm the customizable component selections (Figures 5A-6B). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to

incorporate this feature into the method and program of cited prior art. One of ordinary skill in the art would have been motivated to do so in order to allow a user to see and interact with the configured product.

Referring to claim 118, Motomiya teaches receiving one or more new customizable component selections for at least one of the one or more customizable components of the configured product after said providing the image of the configured product to the client system, wherein the new customizable component selections applied to the configured product specify a new product, and providing an image of the new configured product, wherein the image of the new configured product visually depicts the new customizable component selections of the user (Figures 5A-6B). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate these features into the prior art. One of ordinary skill in the art would have been motivated to do so in order to allow a user to see the product as it was being configured.

Referring to claim 119, Henson teaches receiving user input selecting a first customizable component; providing a menu of possible options for the first customizable component to the client system for display after the user input selecting the first customizable component; receiving user input selecting one of the possible options for the first customizable component (Figures 3A and 4). Henson teaches that the user is provided with scroll-down menus for the customizable components. These menus provide the user with options for each customizable component.

Referring to claim 121, Motomiya teaches providing images of the customizable component options to the client system (Figures 5A-6B). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Motomiya into the method and program of the cited prior art. One of ordinary skill in the art would have been motivated to do so in order to allow the user view each component during the customization process, as taught by Motomiya.

Referring to claim 131, Henson teaches the client system displaying one or more customizable component options of the customizable components in response to said providing the one or more customizable component options of the customizable components to the client system (Figures 3A, 3B, 4, and 5; column 6, lines 18-43). The Examiner notes that once a user clicks on the selection arrow (Figure 4, item "82") a menu opens up which provides a display of the customizable component options of the customizable components. Henson does not teach displaying the image of the configured system wherein the image visually depicts the customizable component selections of the user. However, Henson provides a text display of the configured system (Figure 6, item "104") and shows an image of a "Dell Dimension XPS R" computer system (Figures 3A and Figure 4, item "70"). Furthermore, Motomiya teaches an Internet-based configuration method and program that allows a user to configure a variety of products (Abstract). Motomiya teaches displaying the image of the configured product in response to said providing the image of the configured product to the client system for display, wherein the displayed image of the configured product visually

depicts the customizable component selections of the user (Figures 5A-6B). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Motomiya into the method and program of Henson. One of ordinary skill in the art would have been motivated to do so in order to provide the customer of Henson's product configuration method and program with a visual display of the custom configured product, as taught by Motomiya.

Referring to claim 132, Henson teaches that the customizable component selections include a measurement card (video card and sound card) and a transducer (speakers) (Figures 3A and 4).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naeem Haq whose telephone number is (703)-305-3930. The examiner can normally be reached on M-F 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff A. Smith can be reached on (703)-308 3588. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

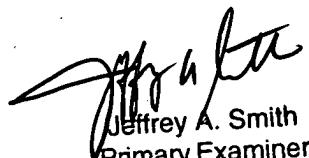
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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Naeem Haq, Patent Examiner
Art Unit 3625

September 15, 2004



Jeffrey A. Smith
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